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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,380	08/30/2001	S. Grant Mulholland	10303-2 US	7757

7590 12/28/2004  
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EXAMINER

LAM, ANN Y

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/943,380

Applicant(s)

MULHOLLAND ET AL.

Examiner

Ann Y. Lam

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-64 and 73-75 is/are pending in the application.
- 4a) Of the above claim(s) 65-72 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,8,10,11,13-26,28-34,39-42,44-53,55-64 and 73-75 is/are rejected.
- 7) ☒ Claim(s) 3-6,9, 12,27,35-38, 43 and 54 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 61-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 61-64 are indefinite because claim 61 recites a "method....comprising the steps of: inserting the suppository of claims 1 or 33". It is unclear whether or not claims 61-64 incorporate all the limitations of the claim from which it depends. (A method claim cannot depend from a device claim. Applicant can overcome the rejection by adding the limitations of the device claims into the method claims.)

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### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 8, 10, 11, 13-15, 18-21, 23, 32-34, 39-42, 44-48, 50, 58, 61 and 64 are rejected under 35 U.S.C. 102(b) as being anticipated by D'Augustine et al., 6,416,779.

As to claims 1, 33, 61 and 64, D'Augustine discloses a urethral suppository (col. 9, line 63) for insertion into a female urethra comprising a non-meltable base member (47); a non-meltable reinforcement (44) having a length, said length having a first end (proximal portion of 44) and a second end (distal portion of 44), said first end attached to said base member and projecting from said base member (see Figure 6); and a meltable portion (medicine, col. 15, line 24) formed around a portion of said length of said reinforcement, said meltable portion having a diameter which tapers from said second end toward said first end (see fig. 6.)

As to claims 2 and 34, the base member (47) is shaped for handling.

As to claims 10 and 41, the reinforcement (44) projects substantially perpendicular from said base member (47.)

As to claims 11 and 42, the reinforcement (44) comprises a rod.

As to claim 15, the second end of the reinforcement (44) extends outside the meltable portion (see fig. 6.)

As to claims 13 and 44, the reinforcement (44) is formed from rubber (see col. 15, line 19.)

As to claim 14, the second end of the reinforcement (44) is contained entirely within the meltable portion (medicine). (Examiner notes that Applicant has not defined

where the "second end" starts, and thus Examiner interprets the "second end" in claim 14 to include part of 44 within the medicine portion.)

As to claims 18-21, 45-48, the reinforcement (44) comprises a restraint.

Also, as to claim 61, a method for delivering therapeutic agents to the female urinary tract using the suppository is disclosed (see column 5, line 20, and column 7, line 60.)

As to claims 8, 40, the base is comprised of polymer (col. 15, lines line 21.)

As to claims 23, 50, the meltable portion comprises antifungals (see col. 20, line 39.)

As to claim 32, 58, the meltable portion is capable of melting within about 2 minutes to about 60 minutes (see medicaments in col. 20, lines 39-43.)

As to claim 39, the base member fits within the labia minora of a patient.

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### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 16, 17, 24, 25, 30, 31, 51, 52, 57, 59, 60, 62, 63 and 73-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Augustine et al., 6,416,779.

D'Augustine discloses the invention substantially as claimed (see above). More specifically, D'Augustine teaches that the suppository is for treatment of various medical conditions in various body parts (see col. 5, lines 12-22.) However, D'Augustine does not teach the dimensions of the suppository as claimed in claims 16, 17, 24, 25, 30, 31, 51, 52, 57, 59, 60 and 73-75.

It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

In this case, D'Augustine teaches the general conditions of the claims (see above with under the 102 rejections). Providing the claimed dimensions as would be necessary to fit inside the urethra, vagina, rectum, pharynx, or other body parts of patients provides optimum or workable ranges and thus involves only routine skill in the art under *In re Aller*.

As to claims, 62 and 63, D'Augustine does not disclose that the device is inserted for about 1 minute to about 10 hours to deliver the therapeutic agent (column 4, lines 30-32.) The claimed period of time for inserting the suppository is an optimum or workable range for delivering the therapeutic agent and thus involves only routine skill in the art under *In re Aller*.

4. Claims 22 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Augustine et al., 6,416,779, in view of Jackson et al., 4,542,020.

D'Augustine et al. discloses the invention substantially as claimed (see above), except for the meltable portion comprising cellulose.

Jackson also teaches a suppository that melts for delivery of medication (column 62-65.) The suppository melts when placed in the patient (column 3, lines 24-28.) Jackson further teaches that the suppository comprises cellulose (column 3, lines 5-10) in order to provide for uniform distribution of the medication (col. 2, lines 6-12.)

It would have been obvious to provide cellulose in the meltable portion of the D'Augustine suppository in order to provide the advantage of uniform distribution of medication as taught by Jackson.

5. Claims 26, 28, 29, 53, 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Augustine, 6,416,779 Sushko, 1,767,785.

<sup>D'Augustine</sup>  
~~Finogold~~ discloses the invention substantially as claimed (see above), except for helical grooves being formed in the meltable portion.

Sushko discloses a urethral suppository. Sushko further discloses helical grooves (11) to retain the suppository inside the urethra (column 2, lines 5, and 54-56.) It would have been obvious to provide helical grooves in the D'Augustine urethral suppository to provide the advantage of retaining the suppository inside the urethra as would be desirable for delivering medication to the urethra, as taught by Sushko.

***Allowable Subject Matter***

7. Claims 3-6, 9, 12, 27, 35-38, 43 and 54 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments with respect to the above rejected claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Y. Lam whose telephone number is 571-272-0822. The examiner can normally be reached on M-Sat 11-6:00.

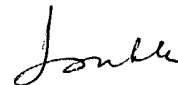
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Art Unit: 1641

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.L.



LONG V. LE  
SUPERVISORY PATENT EXAMINER  
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12/26/07